

Remarks:

Claims 1-18 remain pending in the application. Claims 1-7, 9-15, 17 and 18 stand rejected under 35 USC § 102(e) based on Potts, Jr. (US Patent No. 6,026,432).

Objection to the Title

In the Office action, the Examiner asserts that "the title of the invention is not descriptive," and thus requires that a new title be provided. Without necessarily conceding the Examiner's assertion, applicant has amended the title to read PRINTING NON-DISPLAYED WEBSITE CONTENT VIA A PRINT ACTIVATOR ON A WEB PAGE. Applicant asserts that the proposed new title is descriptive. If the Examiner disagrees, applicant requests that the Examiner specify a title which the Examiner believes would be descriptive.

Claim Rejections Under 35 USC § 102(e)

As noted above, claims 1-7, 9-15, 17 and 18 stand rejected under 35 USC § 102(e) based on Potts, Jr. Potts, Jr. discloses a system and method for retrieving information in a computer network system, and printing of particular pages and documents of such retrieved information.

In particular, Potts, Jr. describes a browser access program having a screen display (200) with control buttons including a "Print" button (215) and a "Print Options" button (320). The Browser access program is capable of calling web page (e.g., targetpage.com), and presenting the called page within a window of the browser. The presented page may be printed using the "Print" button, or using the "Print Options" button. If the "Print Options" button is selected, a list of further menu options is provided, whereby a user can select a "Depth of Call" option "to print

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different depths of link as these links are chased or followed." See, column 5, lines 15-16. In other words, once a target page is accessed and printed, "other HTML's provided in the target page can also be accessed and printed." See, column 5, lines 18-19. Only web pages are printed, and then, only as they are retrieved. See, column 5, lines 52-53. Furthermore, such web pages are printed only via use of the browser print controls.

Claim 1 recites a printing method that includes providing a website with a web page accessible via a browser program that includes browser print controls for initiating processing of print jobs; providing printable content that is associated with the website but not displayed on the web page; providing a print activator on the web page such that activation of the print activator enables a user to initiate printing without having to operate the browser print controls; and in response to user activation of the print activator, printing the printable content at a printer. Potts, Jr. does not disclose or suggest a method which includes "providing a print activator on the web page such that activation of the print activator enables a user to initiate printing without having to operate the browser print controls" as recited in claim 1. Potts, Jr. only describes print operations initiated via operations available via display rows (202) and (210), both of which form a part of the browser interface.

Furthermore, as noted above, Potts, Jr. requires display of web pages in conjunction with printing of such web pages (specifying that the browser may "print different depths of link as these links are chased or followed"). Potts, Jr. thus does not disclose "providing printable content that is associated with the website but not displayed on the web page" as recited in claim 1.

For at least the foregoing reasons, claim 1 is allowable over Potts, Jr., and the rejection of claim 1 under 35 USC § 102(e) should be withdrawn. Claims 2-7 depend from claim 1, and are allowable for at least the same reasons as claim 1. The rejection of claims 2-7 under 35 USC § 102(e) thus also should be withdrawn.

Regarding claim 2, applicant notes that Potts, Jr. in no way suggests that "printed content is a catalog featuring consumer products and/or services." Although the Examiner asserts that the web site specified in the reference "could" provide websites related to products and/or services that "could" be featured in a catalog, the Examiner does not note any suggestion of such a printable catalog in the cited reference. A rejection under 35 USC § 102(e) is improper under these circumstances. Moreover, applicant notes that the only exemplary web site in Potts, Jr. provides links to other web sites entitled "Link of the Day", "Commencement Speech", "Joe's Presentation", "Pat's Presentation", "Sally's Presentation" and "Fred's Presentation". None of these links are related to products and/or services, as the Examiner suggests. The rejection of claim 2 thus should be withdrawn for this reason as well.

Regarding claim 5, which recites that "activation of the print button causes printing to be performed by bypassing the print features provided on the browser program, applicant again notes that Potts, Jr. actually specifically describes use of the browser program (also referred to as the "Internet access program", "browser access program" or "access program") to print. See, column 3, lines 53-55 of Potts, Jr. Any modification of Potts, Jr. to use a print button which bypasses the browser program thus would expressly contradict the expressed intent of Potts, Jr. Claim 6 specifies that "the print button causes the printable content to be downloaded directly

to the printer," contradicting the express teachings of Potts, Jr. that content is first accessed by the browser, and then "ultimately printed." See column 5, lines 50-57 of Potts, Jr.

Claim 9 recites a printing method which includes providing a website with a web page accessible via a browser program that includes browser print controls for initiating processing of print jobs; providing printable content that is associated with the website but not displayed on the web page; displaying a user-actuable print activator on the web page; and in response to activation of the print activator, initiating printing of the printable content at a printer independent of any operation of the browser print controls.

Potts, Jr. does not disclose or suggest a method which includes "providing printable content that is associated with the website but not displayed on the web page," does not disclose "displaying a user-actuable print activator on the web page," and does not disclose "in response to activation of the print activator, initiating printing of the printable content at a printer independent of any operation of the browser print controls," all of which are recited in claim 9. For at least these reasons, claim 9 is allowable over Potts, Jr., and the rejection of claim 9 under 35 USC § 102(e) should be withdrawn. Claims 10-15 depend from claim 9, and are allowable for at least the same reasons as claim 9. The rejection of claims 10-15 under 35 USC § 102(e) thus also should be withdrawn.

Claim 17 recites a system for printing printable content associated with a website, the system including a website with a web page, where the printable content is not displayed on the web page; a computer running a browser program capable of displaying the web page, where the browser program includes browser print controls for initiating processing of print jobs; and a user-actuable print activator displayed on the web page, where, when the web page is displayed by the browser, activation of the print activator initiates printing of the printable content at a printer independent of any operation of the browser print controls. Potts, Jr. does not suggest or describe a user-actuable print activator displayed on the web page, where, when the web page is displayed by the browser, activation of the print activator initiates printing of the printable content at a printer independent of any operation of the browser print controls. Claim 17 thus is allowable over Potts, Jr., and the rejection of claim 17 under 35 USC § 102(e) should be withdrawn.

Claim 18 recites a method of providing a catalog in printed form to a customer, the method including storing the catalog in computer-readable form in a memory location accessible from a communications network; providing a website that is related to products and/or services featured in the catalog; referencing but not displaying the catalog on a web page included on the website, where a user-actuable print activator is displayed on the web page; and in response to customer activation of the print activator, initiating printing of the catalog at a local printer, where the printing is initiated without the customer having to operate print controls included on a browser program used to display the web page.

As noted previously, Potts, Jr. does not suggest or describe providing a printed catalog to a customer. Accordingly, Potts, Jr. does not suggest or describe storing a catalog in computer-readable form in a memory location accessible from a communications network, does not suggest or describe providing a website that is related to products and/or services featured in a catalog, does not describe or suggest referencing but not displaying a catalog on a web page included on the website. Moreover, Potts, Jr. does not disclose or suggest use of a user-actuable print activator displayed on the web page, wherein printing of a catalog at a local printer is initiated in response to customer activation of the print activator, and where "the printing is initiated without the customer having to operate print controls included on a browser program used to display the web page" as recited in claim 18. Claim 18 thus is allowable over Potts, Jr., and the rejection of claim 18 under 35 USC § 102(e) should be withdrawn.

Claim Rejections Under 35 USC § 103(a)

Claims 8 and 16 stand rejected under 35 USC § 103(a) based on Potts, Jr. in view of Goodwin et al. (US Patent Application Publication No. 2002/0099791). By this amendment, applicant has provided a Declaration Under 37 CFR § 1.131, demonstrating conception and diligent reduction to practice by applicant from a time preceding the effective date of Goodwin et al. Goodwin et al. thus is removed as prior art. Claims 8 and 16 are amended to place such claims in independent form, and are thus understood to be allowable over the cited art.

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Conclusion

Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to Examiner S. Yussuf, Group Art Unit 2141, Assistant Commissioner for Patents, at facsimile number (703) 872-9306 on August 11, 2004.



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